

### **REMARKS/ARGUMENTS**

Reconsideration of this application is requested. Claims 1, 2 and 4-8 will be pending in the application subsequent to entry of this Amendment.

The claims have been amended in order to more particularly point out and distinctly claim that which applicants regard as their invention and to agree with the description of the invention. More specifically, claim 1 is amended to exclude the presence of a chromium or chromium compound. This is consistent with the description, for instance on page 2, lines 22-26, page 3, lines 11-15 and specifically the "chrome-free films" mentioned on page 3, line 18. Claims 2 and 7 have been amended to use traditional Markush terminology, claim 7 has been revised to be a fully independent claim and the subject matter of original claim 3 made the subject of new independent claim 8. Favorable consideration of the amended claims and new claim 8 is solicited.

In the Official Action, claims 1-4 and 6 have been rejected as allegedly being anticipated by Miyashita et al U.S. 2003/0022005 while claims 5 and 7 are rejected as allegedly being obvious over the disclosures of that document.

In the Official Action in item 1 A. parts (i)-(v) the examiner explains the reasons why the applied reference is thought to anticipate the claims then being reviewed. However a closer reading of the applied reference will reveal that the subject matter defined by applicants' claims is not disclosed or suggested in the reference applied.

Applicants' claims are directed to a metal plate, a film made from silica and the reaction product of an acid component with a metal or a compound of metal (as described in detail in various claims) then a rubber layer formed on the opposite surface of the metal plate through the film. Key to understanding the invention is that the film is made from silica and the reaction product of an acid component and a metal or compound of a metal other than chromium or a chromium compound. Silica is an essential component of the claim and various types of silica are discussed throughout the description of the invention, in particular in the paragraph bridging pages 5 and 6; metals are described in some detail in the first full paragraph of page 6 of the description.

In contrast to applicants' use of "a reaction product of an acid component and a metal or a compound of a metal other than chromium or chromium compound" the applied reference discloses in the embodiment of paragraph [0027] (as well as paragraph [0020] to which the examiner specifically refers) "a reaction product of aluminum hydroxide and a silane coupling agent". Indeed silane coupling agents are disclosed throughout the applied reference, particularly in paragraph [0027] and also the silane coupling agents used in the examples, for instance paragraphs [0038] and [0043]. Simply stated, a silane coupling agent is not an acid component.

In distinguishing their description from prior procedures the applied reference suggests various disadvantages of the prior art, in particular in paragraph [0007] to which the examiner refers in the Official Action, as well as the embodiment described in paragraph [0027] of the applied reference. The Official Action seems to argue that one having ordinary skill in the art would pick out "phosphoric acid" from paragraph [0007] and use it to replace or interchange with "silane coupling agent" for instance in the embodiment of paragraph [0027]. This is not the case and the applied reference teaches directly in the opposite direction.

The Official Action fails to establish an anticipation. To anticipate a claim, a single reference must disclose the claimed invention with sufficient clarity to prove its existence in the prior art. *Motorola Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Anticipation rejections are only proper when the "claimed subject matter is identically disclosed or described in 'the prior art,' without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972).

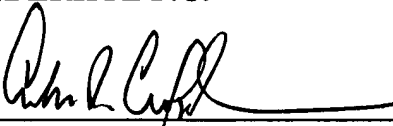
For these reasons it will be apparent that applicants' claims are neither anticipated by or suggested by Miyashita.

Reconsideration and favorable action are solicited. If the examiner requires further information, please contact the undersigned by telephone.

SAITO, H. et al.  
Appl. No. 10/659,272  
March 11, 2005

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:   
\_\_\_\_\_  
Arthur R. Crawford  
Reg. No. 25,327

ARC:eaw  
1100 North Glebe Road, 8th Floor  
Arlington, VA 22201-4714  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100